

REMARKS

Applicant noted that Table I on p. 15 had a typographical error. The first “Example 6” of Table I was renumbered as “Example 5” in the amendment to the specification.

New claims 25-37 have been added. These claims are identical to claims 1-7, 9-13 and 23 except that the phrase “solvent-free” has been deleted.

Specification

The amendment filed on November 20, 2006 is objected to under 35 U.S.C. 132(a) as allegedly introducing new matter into the specification.

§ 112 Rejections

Claims 1 and 19 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement, for the rationale recited in paragraph 6 of Office Action dated January 19, 2007.

The Applicant submits that 35 U.S.C. 1.57(c) permits essential material to be incorporated by reference, by reference to a U.S. Patent or U.S. patent application. Such “essential material” can include material necessary to provide a written description of the claimed invention. (See 35 U.S.C. 1.57(c)(1)

In the response of April 19, 2007, the Applicant stated that the amendment to the specification requested in the response submitted November 20, 2006 is material previously incorporated by reference and that the amendment contains no new matter. Accordingly, the amendment is in compliance with 35 U.S.C. 1.57(f).

The Examiner alleged that “there is no limitation in the specification including the examples (page 13, line 10 through p. 16, line 3) indicating that the polymerizable composition is solvent-free.”

The Applicant submits that one of ordinary skill in the art would deduce from the description of the polymerizable resin composition examples on p. 13, line 27 through p. 15 that since the description of the polymerizable resin compositions does not positively recite the inclusion of any solvent, that the polymerizable resin compositions are solvent-free.

The Applicant respectfully requests entry of the amendment filed on November 20, 2006 and withdrawal on the 35 U.S.C. 112 rejection.

§ 103 Rejections

Claims 1-7, 9-13 and 19 are rejected under 35 USC § 103(a) as being unpatentable over Olson et al. (US Patent 6261700) in view of Williams et al. (US Patent 5626800) and further in view of Martens (US Patent 4576850) for the rationale recited in paragraph 8 of Office Action dated January 19, 2007.

Claims 23 and 24 are rejected under 35 USC § 103(a) as being unpatentable over Olson et al. (US 6261700) in view of Williams et al. (US 5626800) and Martens (US 4576850).

The primary reference being relied upon is Olson et al. (US Patent 6261700).

According to MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

With respect to the first criteria, Applicant has previously argued that there is no motivation to use the coating composition of Olson et al. to prepare a brightness enhancing film, such as by depositing the polymerizable composition onto a molding surface to fill cavities of

the molding surface between a preformed substrate and the molding surface, and ultraviolet curing the polymerizable composition (such as recited by dependent claim 23).

With respect to the second criteria, in consideration of the declaration of David B. Olson there is no reasonable expectation that a solvent containing polymerizable coating composition is suitable for the manufacture of prisms of a brightness enhancing film using a casting and curing process (such as set forth in claim 23).

The Examiner stated that, "it is noted that the supporting statement should be in the specification, not in the Declaration."

The Applicant submits that 37 CFR 1.132 clearly provides for the submission of evidence by way of a declaration to traverse a rejection.

With respect to the third criteria, Olson et al. does not teach a composition "consisting essentially" of a) one or more first monomers as recited in the claims, b) at least 25 wt-% of 2,4,6-tribromophenoxyethyl (meth)acrylate, c) from 5 wt-% to 30 wt-% of a crosslinking agent as recited in the claims and optionally a monofunctional diluent and/or a photoinitiator.

Rather, Olson et al. describes composition comprising inorganic oxide particles and polymerizable brominated compounds. Although RDX-51027 is a preferred monomer, tribromo phenyl ethyl (meth)acrylate is described as being an alternative to RDX-51027. Thus, Olson et al. fails to describe RDX-51027 in combination with tribromophenoxyethyl (meth)acrylate, particularly at least 25 wt-% or at least 50 wt-% of tribromophenoxyethyl (meth)acrylate as set forth in dependent claims 5 and 6.

Further, the declaration of David B. Olson provides proof that the inclusion of solvent materially affects the suitability of the polymerizable resin for use in making prism structures via a cast and cure process.

Accordingly, the Applicant submits that the rejection based on Olson et al. fails to meet any of the criteria for establishing a *prima facie* case of obviousness, let alone meeting all three criteria.

The Applicant would like to bring to the Examiner's attention that Control 1 (p. 15, Table I) is similar to compositions described in U.S. Patent No. 5,908,874 except that the composition of U.S. Patent No. 5,908,874 further comprises a fluorochemical. Control 1 contains the same first monomer as Examples 5 at a concentration of 20 wt-%. Control 1 also contains the same second monomer and PEA (phenoxyethyl acrylate) at substantially the same concentrations as Example 5. As described on p. 14, lines 9-14, Control 1 contain 20 wt-% EB-9220; whereas Example 5 contains 19.9 wt-% PETA (pentaerythritol triacrylate). As evidenced by the attached declaration of David B. Olson, EB-9220 is an aromatic urethane hexaacrylate crosslinker having a refractive index of 1.51; whereas PETA of Example 5 has a refractive index of 1.48. Since PETA has a lower refractive index than EB-9220, the refractive index of the polymerizable composition of Example 5 is also lower than Control 1. It is a surprising result that Example 5 exhibits the same single sheet (SS) and cross-sheet (XS) gain. Likewise, the polymerizable composition of Example 8 containing 19.9 wt-% TMPTA has a lower refractive index than the polymerizable composition of Control 2. However, Example 8 also exhibited the same single sheet gain and substantially the same cross-sheet gain as Control 2. This achievement of comparable gain using lower refractive index components is an unexpected result of the claimed polymerizable resin compositions.

Reconsideration and a timely allowance are respectfully requested.

Respectfully submitted,

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Date

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